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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,741	08/17/2001	Lee E. Cannon	4657US(300-015)	4593

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EXAMINER
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THOMASSON, MEAGAN J

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/932,741

Applicant(s)

CANNON, LEE E.

Examiner

Meagan Thomasson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 41, 51-80, 102, 103 and 105 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38, 39, 42-50, 81-101, 104 and 106 is/are rejected.
- 7) ☒ Claim(s) 42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/17/01, 11/20/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 1, 2007 has been entered.

### ***Response to Amendment***

The examiner acknowledges the amendments made to claims 38,81,99 and 106. Claims 40,41,51-80,102,103 and 105 have been canceled.

### ***Claim Objections***

Claim 42 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 42 recites "the method of claim 41", however claim 41 has been canceled by the applicant. The examiner assumes this to be an inadvertent error and, for the purposes of this

action, claim 42 will be treated as being dependent from claim 38. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 38,39,42-50,81-84,90-101,104 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell II (US 5,393,057) in view of Yoseloff (US 6,398,645) and further in view of Walker et al. (US 6,364,765 B1).**

Regarding claim 1,42,81,83,96-100 Marnell discloses a method of facilitating play of a group game, comprising;

In each of a plurality of plays of individual games played by a plurality of players at respective gaming machines, generating an outcome for the individual game, the outcome being one of a plurality of outcomes including at least a first set of outcomes

and a second set of outcomes. Specifically, Marnell discloses an individual slot machine game wherein an outcome is generated in the form of a poker hand (abstract).

Displaying a first group of cells and an associated first value payout, each cell in the first group of cells capable of being designated with a designator in response to any player of the plurality of players achieving an outcome in the first set of outcomes, wherein the designator indicates the gaming machine at which the outcome in the first set of outcomes was generated. That is, Marnell discloses a secondary game featuring a bingo card matrix (Fig. 1, [51]) comprising a first group of cells [52], wherein the occurrence of an outcome in the first set of outcomes results in a gaming machine designator being placed on the cell containing said outcome (col. 6, lines 1-8).

Designating a corresponding cell of the first group of cells with the designator responsive to an occurrence of any outcome from the first set of outcomes if the outcome generated for the individual game is from the first set of outcomes. In the example given in col. 6, lines 1-8, gaming machine #7 achieved an outcome comprising three queens, resulting in a "#7" being placed in the cell containing the "3Q" outcome.

*Marnell does not specifically disclose displaying a second group of cells and an associated second value payout while displaying the first group of cells and the associated first value payout, each cell in the second group of cells capable of being designated with the designator in response to any player of the plurality of players achieving an outcome in the second set of outcomes, wherein the designator indicates the gaming machine at which the outcome in the second set of outcomes was generated.* However, in an analogous gaming machine invention, Yoseloff discloses an

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electronic video bingo game with multi-card play ability. That is, Yoseloff features a plurality of groups of cells, i.e. bingo card matrices, displayed simultaneously, wherein each bingo card may have an individual associated value payout as the payout may be determined according to the wager amount placed on an individual card by a player (col. 10, lines 60-65). The second group of cells, i.e. the second bingo card, is non-overlapping with the first group of cells (Fig. 1). If the player achieves an outcome in the second set of outcomes, a designator is placed in the cell containing said outcome. Further, Yoseloff discloses displaying a payout value associated with a game, i.e. bingo card, in col. 8, lines 5-8.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marnell and Yoseloff as it is notoriously well known to allow a bingo player to play multiple cards simultaneously. This is a common practice in the gaming industry and does not present a new, novel or unobvious feature to the invention of the instant application. Further, Yoseloff specifically discloses an embodiment of the invention wherein a player may simultaneously play a video poker and bingo game on a single gaming machine (col. 10, lines 3-9), which is an embodiment similar to that disclosed by Marnell.

*Marnell does not specifically disclose apportioning at least one of the first value payout among a first plurality of players or the second value payout among a second plurality of players, wherein apportioning the first value payout or the second value payout comprises apportioning based on the number of designations of each gaming machine in the designated cells of the corresponding first group of cells or the second*

*group of cells*. However, in an analogous gaming machine invention, Walker discloses a slot machine gaming device featuring a cooperative secondary game wherein team members attempt to obtain pre-determined outcomes in order to be awarded a bonus prize (col. 6, lines 37-40) i.e. team members attempt to fulfill a group goal. Upon obtaining all required outcomes, the team members are awarded a bonus prize that may be divided among the group of players (col. 6, lines 62-66). Specifically, the bonus amount may be divided among team members in proportion to the game requirements that were achieved by the individual players (col. 15, lines 10-14). That is, the payout value may be apportioned among players based on the number of outcomes achieved by each individual player on the team.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the slot machine gaming device featuring a group of cells, an associated payout value, and indicators assigned to a cell upon occurrence of an outcome with the payout apportionment method of Walker as the inventions are in the same field of endeavor, i.e. the electronic gaming field wherein games comprise features designed to heighten player excitement and entertainment. Further, Marnell discloses that the bonus payout may be divided among participants such that the participant who contributed the most to obtaining the bonus payout may receive a greater proportion of that bonus payout, however Marnell discloses the participant who contributed the most to obtaining the bonus payout is the participant who obtained the more "difficult" poker hand. Thus, to award the player for being the largest contributor in

terms of number of cells filled would have been an obvious variation of the invention disclosed by Marnell.

Regarding claim 39, Yoseloff discloses that a payout is awarded according to the group of cells, i.e. the bingo card, containing cells that have been designated in accordance with a winning pattern. That is, if a player is using a plurality of cards, whichever card the player obtains a winning combination of cells on first is the card for which the player receives a payout (col. 9, lines 26-27).

Regarding claims 43 and 44, Fig. 2 of Yoseloff discloses cell groups in various patterns, including a first group of cells comprising a first row of cells (3 Number Single 1J) and the second group of cells comprises a second row of cells (Two Number Single 1K). Additionally, Yoseloff discloses the first group of cells comprises a first column of cells and the second group of cells comprises a second column of cells (Parallel Double 1D).

Regarding claim 45-49,94,104 Marnell discloses the groups of cells are labeled with playing card indicia (Fig. 1) and that the individual game comprises draw poker (Fig. 1).

Regarding claims 50,95 Yoseloff discloses designating the card indicia comprises crowning the card indicia (col. 10, lines 10-15).

Regarding claims 81,106, in addition to the invention as described above, Marnell discloses each cell is capable of being designated to multiple gaming machines as Marnell discloses the poker gaming device of the invention as comprising an electronic device including a display such as a bingo matrix including a plurality of



spaces wherein upon occurrence of selected poker hands the gaming device activates the space containing said poker hand (col. 2, lines 35-62). Further, Marnell discloses that a plurality of electronic gaming apparatus of the type as described may be electrically connected in a common carousel (col. 4, line 63-67; Fig. 5).

Regarding claim 84, Marnell discloses the plurality of cells are arranged in order, i.e. random, wherein designating the cell of the plurality of cells comprises designating a next cell in the order from the plurality of cells (Fig. 1).

Regarding claims 90-93, Marnell discloses each cell of the first plurality of cells corresponds to at least one outcome from the first set of outcomes (Fig. 1). Further, achieving a goal, i.e. a winning outcome, requires that all of the cells in the first plurality of cells are designated. That is, all cells required to form a bingo winning outcome must be designated. If a cell is to be designated, the previous designation is removed. For instance, as shown in Fig. 1, machine number 7 obtained a 3 Queens outcome and the designation "3Q" for that particular cell was replaced with "#7". If a cell has already been designated with a machine number, obtaining the same hand a second time will not replace the current cell designation (col. 6, lines 14-17).

Regarding claim 101, Marnell discloses displaying an image representative of an individual game played by one of the plurality of players (Fig. 1, draw poker display [28]).

**Claims 85-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell in view of Yoseloff (US 6,398,645 B1), Walker et al. (US 6,364,765 B1) and further in view of Baerlocher et al. (U.S. Patent No. 6,648,754 B2).**

Marnell lacks in disclosing the image of a ladder or lane. Baerlocher teaches of a gaming device in which an image representative of a game includes a ladder/lane, the ladder/lane comprises a first plurality of cells with a bottom/beginning and a top/end. Designation of the cell from the first plurality of cells comprises designating the next undesignated cell from the bottom of the ladder [claims 85, 87]. If the next undesignated cell is designated, an image of a figure on the ladder/lane moving toward the top/end by one cell is displayed [claims 86, 88]. (See Baerlocher Fig. 6; col. 11 lines 1-18). For example, random selections are made which move the man up the ladder the number of spaces that are selected towards an overall jackpot goal. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the object in the lane of Baerlocher be a car because Applicant has not disclosed that the use of a car, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Baerlocher's game, and applicant's invention, to perform equally well with any object moving up the ladder/lane. Therefore, it would have been prima facie obvious to modify Baerlocher to obtain the invention as specified in claim 89 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Baerlocher. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a ladder or

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lane in the invention of Marnell so that one moves from one space in a sequential order. For example, one could consider the last row of the bingo matrix of Marnell to be the bottom/beginning of a ladder/lane as in Baerlocher and require a player to complete the matrix cells in a sequential order so that one could achieve the jackpot prize. By requiring a player to climb a ladder or lane, and thereby achieve cells in a sequence, the player can visually see how many more cells they need to complete before a prize is awarded.

### ***Response to Arguments***

Applicant's arguments with respect to claims 38,39,42-50,81-101,104 and 106 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

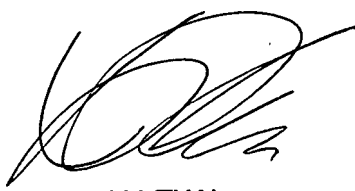
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner  
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Meagan Thomasson  
July 5, 2007



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TC3700